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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant : Mark D. Conover   Docket no. 2134

Serial no : 09/168,644

Filed   : October 8, 1998

For   : ENCODING A STILL IMAGE
            INTO COMPRESSED VIDEO

Art Unit : 2613

Examiner: Richard J. Lee

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Sir:

REPLY BRIEF

Pursuant to 37 C.F.R. § 1.192, through his undersigned attorney the Appellant submits the following brief, in triplicate, in reply to an Examiner's Answer mailed December 24, 2003.

Argument

As established below, the Examiner's Answer repeatedly contradicts itself, i.e. makes a particular allegation or admission at one point in the text of the Examiner's Answer only, when apparently argumentatively convenient, at another point in the text to expressly contradict or repudiate the allegation or admission. As demonstrated in detail below, the sophistry appearing in the Examiner's Answer is, perhaps, only bettered by that exhibited by Enron's accountants and counsel. While "[a] foolish consistency is the hobgoblin of little minds,"[1] surely arguments and rationales appearing in an Examiner's Answer which contains numerous express, internal contradictions are entitled to little or no weight in deciding if the claims pending in the present application are patentable. Finally, for the reasons explained in greater detail below, only by impermissibly first ascertaining factually what the inventor did and then viewing the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct the invention therefrom, can the Examiner's Answer justify rejecting claims 1-7 now pending in this patent application.

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[1]   Ralph Waldo Emmerson, *Essays: First Series [1841] History*.

-2-

Condensed down to its essentials, Appellant's voluminous Appeal Brief establishes the following reasons why claims pending in this application traverse rejection despite contrary arguments appearing in the Examiner's Answer.

1. Claims 1-3 and 5-7 traverse rejection under 35 U.S.C. § 103(a) for obviousness based upon the Bowater, et al. patent combined with any other reference because the cited reference fails to disclose the method step of:

    > fetching the data for the still image. (Appeal Brief pages 24-27)

2. Claims 1-3 and 5-7 traverse rejection under 35 U.S.C. § 103(a) for obviousness based upon the Bowater, et al. patent combined with any other reference because the cited reference fails to disclose the method step of:

    > encoding the data for the single still image into data for an I frame. (Appeal Brief pages 27-29)

    Note first, that the Examiner's Answer on page 5 in line 11 expressly admits that the Bowater, et al. patent fails to disclose the preceding method step. Please also further note that **the preceding admission** that appears on page 5 in line 11 **expressly contradicts a prior allegation**, which begins in the Examiner's Answer on page 4 in the last line and continues onto page 5 in line 1, that the Bowater, et al. patent

-3-

discloses "encoding . . . the data for the single still image data . . . ." In view of the express contradiction identified above between different sections of the Examiner's Answer, the Appellant respectfully submits that the Examiner's Answer does not identify in the cited references a valid basis for rejecting claims 1-3 and 5-7 for obviousness under 35 U.S.C. § 103(a).

3.   Claims 1-3 and 5-7 traverse rejection under 35 U.S.C. § 103(a) for obviousness based upon the Bowater, et al. patent combined with any other reference because the cited reference fails to disclose the method step of:

> storing the encoded I frame data.   (Appeal Brief pages 30-31)

Note first that the Examiner's Answer on page 5 in lines 11 and 12 admits that the Bowater, et al. patent fails to disclose the preceding method step. Please also further note that **the preceding admission** that appears on page 5 in lines 11 and 12 **expressly contradicts a prior allegation**, which begins in the Examiner's Answer on page 5 in line 1, that the Bowater, et al. patent discloses "storing . . . the encoded frame data . . . ." In view of the express contradiction identified above between different sections of the Examiner's Answer, the Appellant respectfully submits that the Examiner's

-4-

Answer does not identify in the cited references a valid basis for rejecting claims 1-3 and 5-7 for obviousness under 35 U.S.C. § 103(a).

4. Claims 1-3 and 5-7 traverse rejection under 35 U.S.C. § 103(a) for obviousness based upon the Bowater, et al. patent combined with any other reference because the cited reference fails to disclose the method step of:

> assembling the compressed video bitstream by appropriately combining data for:
> at least a single copy of the stored I frame;
> at least one null frame. (Appeal Brief pages 31-36)

Note first that the Examiner's Answer on page 5 in lines 12 and 13 admits that the Bowater, et al. patent fails to disclose the preceding method step. Please also further note that **the preceding admission** that appears on page 5 in lines 12 and 13 **expressly contradicts a prior allegation**, which begins in the Examiner's Answer on page 5 in line 2, that the Bowater, et al. patent discloses "assembling the compressed video bitstream by appropriately combining data for at least a single copy of the stored frame . . . , at least one null frame . . . ." In view of the express contradiction identified above between different sections of the Examiner's Answer, the Appellant respectfully submits that the Examiner's Answer does not identify in the cited references a valid basis

-5-

for rejecting claims 1-3 and 5-7 for obviousness under 35
U.S.C. § 103(a).

5.   Claims 1-3 and 5-7 traverse rejection under 35 U.S.C. § 103(a)

for obviousness based upon the Bowater, et al. patent combined

with any other reference because the cited reference fails to

disclose the operation required by the whereby clause of:

> decoding of the compressed video bitstream produces
> frames of video which produce images that do not
> appear to pulse visually.   (Appeal Brief pages
> 36-40)

6.   Claims 1-3 and 5-7 traverse rejection under 35 U.S.C. § 103(a)

for obviousness based upon the Bowater, et al. patent in view

of the Davis, et al. patent because the references do not

suggest their combination.   (Appeal Brief pages 43-45)

7.   Claims 1-3 and 5-7 traverse rejection under 35 U.S.C. § 103(a)

for obviousness based upon the Bowater, et al. patent in view

of the Davis, et al. patent because combining the references

is unobvious since the combination renders the reference

unusable for its intended purpose. (Appeal Brief pages 45-48)

8.   Claim 4 traverses rejection under 35 U.S.C. § 103(a) for

obviousness based upon the Bowater, et al. and Davis, et al.

-6-

patents in view of the Florencio patent because the combined

references fail to disclose the method step of:

> parameters used in encoding the data for the still
> image produce an amount of data for the I frame
> that approaches, but remains less than, storage
> capacity of a buffer memory included in a decoder
> that stores the compressed video bitstream. (Ap-
> peal Brief pages 50-51)

9.   Claims 2 and 3 traverse rejection under 35 U.S.C. § 112,

second paragraph because, as established by the October 11,

2002, Declaration of Mark Conover, there exists no reasonable

likelihood that it might become impossible to practice the

invention of claims 2 and 3 during the term of any patent

issuing from the present application. (Appeal Brief pages 52-

54)

Reason No. 1
Still Images

With regard to reason no. 1 above, the Examiner's Answer in

the last four (4) lines on page 4 alleges that the Bowater, et al.

patent discloses:

> compressed video data for a plurality of frames **that**
> **specifies a single still image** . . . , comprising
> substantially the same fetching the (sic) data for the
> still image . . . . (Emphasis supplied.)

The texts from the Bowater, et al. patent identified at this point

in the Examiner's Answer to support the preceding allegation, i.e.

column 3, lines 19-34 and column 4, lines 42-68, appear on pages 24

-7-

through 26 of Appellant's Appeal Brief. As established in footnote 16 to Appellant's Appeal Brief which begins on page 24, **the text of the Bowater, et al. patent in column 3 at line 46-49, a text which the Examiner's Answer scrupulously avoids, expressly contradicts the preceding allegation that the "plurality of frames . . . specifies a single still image."**

By ignoring the text of the Bowater, et al. patent in column 3 at lines 46-49, the Examiner's Answer disobeys the mandates of Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 448, 230 USPQ 416, 420 (Fed. Cir. 1986), and of In re Hedges, et al., 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986) that **the prior art as a whole must be considered, and those portions of the prior art arguing against or teaching away from the claimed invention must be considered**.

Not only does the Examiner's Answer go so far as to ignore those portions of the prior art Bowater, et al. patent that argue against or teach away from the claimed invention, in attempting to avoid independent claim 1's "still image" limitation **on page 8 in lines 16-19 the Examiner's Answer even goes so far as to avoid the express language of that claim**. On page 8 in lines 16-19 the Examiner's Answer declares:

> in the preamble of claim 1, it recites a method of producing a compressed video bitstream, and further in claims 2 and 3 reciting the compressed video bitstream being in compliance with the MPEG-1 and MPEG-2 standards.

-8-

It is clear from the claimed limitations that the present invention deals with motion video. (Emphasis supplied.)

Contrast the preceding assertion excerpted from page 8 of the Examiner's Answer with the text excerpted below from pending independent claim 1.

> 1.   A method for producing a compressed video bitstream that includes compressed video data for a plurality of frames **from data that specifies a single still image**, the method comprising the steps of:
> fetching the data for **the still image**;
> encoding the data for **the single still image** into data for an I frame;
>   *   *   *

How could anyone possibly allege, in good faith, that a claim which includes not only in the preamble, but also in its first two steps, the express limitation that the method applies to a "still image" allege as in the Examiner's Answer, that:

> **[i]t is clear from the claimed limitations that the present invention deals with motion video**. (Emphasis supplied.)

Not only does the preceding allegation violate the mandate of Litton Industrial Products, Inc. v. Solid State Systems Corp., 755 F.2d 158, 164, 225 USPQ 34, 38 (Fed. Cir. 1985) that the claimed invention must be considered as a whole, **the allegation also expressly contradicts an admission in the Examiner's Answer** at the top of page 3 in section (5) that "[t]he summary of invention contained in the brief is correct." The "Summary of the Invention"

on pages 5-7 of Appellant's Appeal Brief, in no fewer than nine (9)

places, describes the invention as applying to "still images."

Yet another, subtler, express contradiction exists in the

Examiner's Answer which is relevant to Reason no. 1. On page 4

beginning in the last four lines the Examiner's Answer alleges that

the Bowater, et al. patent discloses:

> compressed video data for a plurality of frames **that**
> **specifies a single still image** . . . , comprising
> substantially the same fetching the (sic) data for the
> still image . . . . (Emphasis supplied.)

Yet on page 5 in line 11 the Examiner's Answer expressly admits

that the Bowater, et al. patent fails to particularly disclose:

> encoding the data for **the single still image** into data
> for an intra frame. (Emphasis supplied.)

How can the Bowater, et al. patent disclose "compressed video data

for a plurality of frames **that specifies a single still image** . .

. , comprising substantially the same fetching the (sic) data for

the still image," yet at the same time fail to disclose "encoding

the data for **the single still image** into data for an intra frame."

If the Bowater, et al. patent discloses fetching data for the still

image, wouldn't it encode the data for the still image. Alterna-

tively, If the Bowater, et al. patent fails to disclose encoding

the data for the still image, wouldn't it also fail to disclose

fetching data for the still image. Only in Wonderland can the

texts excerpted above from pages 4 and 5 of the Examiner's Answer

be reconciled.

Docket no. 2134   February 23, 2004

Consequently, with respect to reason no. 1 above claims 1-3 and 5-7 traverse rejection under 35 U.S.C. § 103(a) for obviousness based upon the Bowater, et al. patent, at least because the Examiner's Answer:

1. makes a particular allegation or admission at one point in its text only to expressly conradict or repudiate the allegation or admission at another point in the text;

2. wrongfully ignores portions of the Bowater, et al. patent which argue against or teach away from the claimed invention; and

3. wrongfully refuses to consider the claimed invention as a whole.

Reason No. 5
Decoded Images Do Not Pulse Visually

With regard to reason no. 5 above, the Examiner's Answer in lines 5-9 on page 5 alleges that the Bowater, et al. patent discloses:

> decoding of the compressed video bitstream produces frames of video which produce images that do not appear to pulse visually . . . .

The texts from the Bowater, et al. patent identified at this point in the Examiner's Answer to support the preceding allegation, i.e. column 3 from line 19 to column 4 at line 41, appear on pages 37 through 40 of Appellant's Appeal Brief. As established in footnote

-11-

19 to Appellant's Appeal Brief which begins on page 24, the text of the Bowater, et al. patent expressly states that the invention disclosed there does not prevent video images from freezing.

One searches in vain the Examiner's Answer for any admission that the Bowater, et al. patent discloses that video images produced by its invention freeze, or for any response to the Appeal Brief's exposition regrading freezing of images. Thus again, the Examiner's Answer disobeys the mandates of <u>Bausch & Lomb</u> supra, and of <u>In re Hedges</u> supra, that **the prior art as a whole must be considered, and those portions of the prior art arguing against or teaching away from the claimed invention must be considered**.

Reason No. 6
No Motivation to Combine References

With regard to reason no. 6 above, the Examiner's Answer beginning in line 11 on page 6 states that:

> Therefore, it would have been obvious to one of ordinary skill in the art, having the Bowater et al and Davis et al references in front of him/her and the general knowledge of intra frame processings within the MPEG video compression standard, would have had no difficulty in providing the intra frame processings as taught by Davis et al within the encoder and decoder of Bowater et al thereby providing the encoding of the data for the single still image into data for an intra frame, storing the encoded I frame data, and wherein the assembling the compressed video bitstream combines at least a single copy of the stored I frame if such intra frame processing were not already within the encoding/decoding of Bowater et al for the same well known purposes as claimed.

To justify combining the disclosures of the Bowater, et al. and

Davis, et al. patents without finding any suggestion therein to

combine those references, the Examiner's Answer on page 12 in lines

6-11 argues:

> [o]ne of ordinary skill in the art is presumed to possess
> a certain amount of background knowledge independent of
> the references. In re Sovish, 769 F.2d 738, 226 USPQ 771
> (Fed. Cir. 1985); In re Jacoby, 309 F.2d 513, 135 USPQ
> 317 (C.C.P.A. 1962). The conclusion of obviousness may
> be made from common knowledge and common sense of a
> person of ordinary skill in the art without any specific
> hint or suggestion in a particular reference. In re
> Bozek, 416 F.2d 1385, 163 USPQ 545 (C.C.P.A. 1969).

Contrast the holding cited above from the archaic In re Bozek

decision with that expressed in the more recent Court of Appeals

for the Federal Circuit decisions identified below. "**[E]lements of**

separate prior patents cannot be combined when there is no

suggestion of such combination anywhere in those patents". Panduit

Corp. v. Dennison Manufacturing Co., 810 F.2d 1561, 1568, 1 USPQ2d

1593, 1597 (Fed. Cir. 1987) citing ACS Hospital Systems, Inc. v.

Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.

Cir. 1984). (Emphasis supplied.) **An examiner is obliged to**

explain why combining references is proper indicating why one

skilled in the art would make a combination or substitution. Ex

parte Skinner, 2 USPQ2d 1788, 1790 (Bd. Pat. App. & Int. 1986).

"In reviewing the Board's obviousness conclusions, we have been

guided by the **well-settled principles** that **the claimed invention**

must be considered as a whole, **multiple cited prior art references**

must suggest the desirability of being combined, and the references must be viewed without the benefit of hindsight afforded by the disclosure." In re Paulsen, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994). "[T]he absence of such a suggestion to combine is dispositive in an obvious determination." Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1578-79, 42 USPQ2d 1378, 1383, 1384 (Fed. Cir. 1997) (Emphasis supplied)

In Ecolochem, Inc. v. Southern California Edison Company, 227 F.3d 1361, 1371-72, 56 USPQ2d 1065, 1072-73 (Fed. Cir. 2000), the Court of Appeals for the Federal Circuit declared that:

> [i]n In re Dembiczak, we noted that:
>
> > Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.
>
> In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). We "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988).
>
> Our case law makes clear that **the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.** See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." Id.

-14-

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)).

<div align="center">*   *   *</div>

"**Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.**" ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Although the suggestion to combine references may flow from the nature of the problem, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), "**[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness,**" Monarch Knitting Mach. Corp. v. Sulzer Morat Gmbh, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, '**the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.**'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann, 730 F.2d at 1462, 221 USPQ at 488). (Emphasis supplied.)

Since for the reasons set forth herein and in Appellant's Appeal Brief both the Bowater, et al. and the Davis, et al. patents disclose processing moving images, as contrasted with still images encompassed by pending claims 1-7, the motivation excerpted above from page 6 at line 11 of the Examiner's Answer wrongfully defines the problem in terms of its solution. Only by impermissibly first ascertaining factually what the inventor did and then viewing the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to

reconstruct the invention therefrom, can the Examiner's Answer justify rejecting claims 1-7 now pending in this patent application. Panduit Corp. v. Dennison Manufacturing Co., 774 F.2d 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985).

Reason No. 7
Unobvious, Inoperable Combination

The invention encompassed by pending independent method claim 1 produces a compressed video bitstream, inter alia, by "encoding the data for the single still image into data for an I frame." The Bowater, et al. patent discloses that:

> a first computer 4 obtains a video signal, normally of the user, which is compressed and submitted to the network. The signal is then transmitted down the [asynchronous] communication channel [15] in packet format before arriving at the destination computer 6. Typically, this second computer [6] includes hardware such as the Intel/IBM ActionMedia II (AMII) card [i.e. a decoder], which is responsible for actually decompressing and displaying the video image on the screen 9. (Col. 3, lines 21-29)[2]

The Bowater, et al. patent nowhere expressly uses the words "encoder" and "decoder," even though:

1. the functionality of an encoder must inherently reside in the first computer 4; and

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[2]   As depicted in FIG. 1 of the Bowater, et al. patent, only the first computer 4 transmits a compressed video signal, i.e. a compressed video bitstream, down the asynchronous communication channel 15 in packet format.

-16-

    2.   the functionality of a decoder must inherently reside in a workstation 13 of the destination computer 6.[3]

With regard to reason no. 7 above, the Examiner's Answer in lines 22-23 on page 13 alleges that:

> **[t]he rejection in view of the combination of Bowater et al and Davis et al does not involve the modification of Figure 1 of Bowater et al as presented by the appellant in Exhibit H.** (Emphasis supplied.)

Contrast the preceding allegation excerpted from the Examiner's Answer with the text which begins in line 11 on page 6 of the Examiner's Answer which expressly describes the modification that must be made to the network 2 of computers 4, 6 and 8 of the Bowater, et al. patent to obtain a structure which allegedly renders claims 1-7 obvious. Beginning in line 11 on page 6 the Examiner's Answer expressly states:

> [t]herefore, . . . one of ordinary skill in the art, . . . , would have had no difficulty in providing the

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[3]   While the AMII card 125 depicted in FIG. 2 is a decoder, the word "decoder" appears nowhere in the text of the Bowater, et al. patent. The word "encoded" appears only twice in the entire text of the Bowater, et al. patent in two separate sentences which appear in col. 4 in lines 50-58.

To clearly establish where the encoder and decoder are located in the Bowater et al. patent, Exhibit A hereto reproduces FIGs. 1 and 2 therefrom annotated to indicate that:
1.   the first computer 4 inherently includes an encoder; and
2.   the workstation 13 of the destination computer 6, which includes the AMII card 125, inherently includes a decoder.

intra frame processings as taught by Davis et al **within the encoder and decoder of Bowater et al** thereby providing the encoding of the data for the single still image into data for an intra frame, ... (Emphasis supplied.)

Since the immediately preceding excerpt from the Examiner's Answer expressly declare that intra frame processing as taught by Davis et al must be provided **within** both **the encoder** in the first source computer 4 **and decoder** in the workstation 13 of the destination computer 6 **of Bowater et al**, Exhibit H to Appellant's Appeal Brief graphically and properly depicts fusing the source computer 4 with the destination computer 6. How could one possibly provide "the intra frame processing as taught by Davis et al **within the encoder and decoder of Bowater et al**" that the Examiner's Answer mandates without fusing into a single unit the two computers 4 and 6 which must, as explained above, respectively include the encoder and decoder?[4]

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[4] The only rational explanation for the argument appearing in the Examiner's Answer that a combination of the cited references, which the Examiner's Answer alleges renders claims 1-7 obvious, does "**not require the modification to figure 1 of Bowater as stated by the appellant**" is that its author must think that the first computer 6 includes both the encoder and the decoder. If one recognizes that the first computer 6 must inherently include the encoder, and that the workstation 13 of the destination computer 6 must inherently include the decoder, then, rationally, one must fuse together the computers 4 and 6 if "the intra frame processings as taught by Davis et al [is to be located] **within the encoder and decoder of Bowater et al**."

Docket no. 2134   February 23, 2004

However, as stated on page 47 of Appellant's Appeal Brief after combining the encoder of computer 4 with the decoder of computer 6, the signal is no longer transmitted from the first computer 4 down the asynchronous communication channel 15 in packet format before arriving at the destination computer 6. Because, the asynchronous communication channel 15 no longer interconnects the fused computers 4 and 6, frames of video data no longer arrive irregularly at the destination computer 6 due to their transmission across an asynchronous or non-ideal network, i.e. the asynchronous communication channel 15. Because frames of video data no longer arrive irregularly at the destination computer 6, there no longer exists any need for the invention disclosed in the Bowater, et al. patent which accommodates frames of video data arriving irregularly at the destination computer 6. Therefore, **combining the disclosures of the Bowater, et al. and Davis, et al. patents as required by the Examiner's Answer**, i.e. fusing into one the computers 4 and 6 as illustrated in Exhibit H, **renders the invention disclosed in that reference no longer useable for its intended purpose**.

Furthermore, the allegation excerpted above from the Examiner's Answer in lines 22-23 on page 13, by repudiating the modification of FIG. 1 illustrated in Exhibit H, expressly denies the allegation excerpted above beginning in line 11 on page 6. As observed previously, how could one possibly provide "the intra frame processing as taught by Davis et al **within the encoder and**

-19-

decoder of Bowater et al" mandated by the Examiner's Answer without
fusing into a single unit the two computers 4 and 6 which respec-
tively include the encoder and decoder?

Reason No. 8
Encoding Parameters

With regard to reason no. 8 above, the Examiner's Answer on
page 7 beginning in line 10 admits that:

> [t]he combination of Bowater et al and Davis et al
> discloses substantially the same method for producing a
> compressed video bitstream as above, but does not
> particularly disclose wherein parameters used in encoding
> the data for the still image produce an amount of data
> for the I frame that approaches, but remains less than,
> storage capacity of a buffer memory included in a decoder
> that stores the compressed video bitstream as claimed in
> claim 4.

On page 14 beginning in line 18 the Examiner's Answer admits that:

> Florencio teaches an MPEG-like **decoder** as shown in Figure
> 1, the particular **I, P, and B frames are therefore being
> decoded within the decoder** of Florencio.

Then beginning in the last line on page 14 and continuing to line
4 on page 15 the Examiner's Answer asserts:

> the critical issue at hand is not the amount of variable
> length encoded bitstream data which the input buffer
> memory module 111 may receive for a single encoded frame
> of video or how the amount of variable length encoded
> bitstream is received by the input buffer memory module
> 11 relates to the size of the input buffer memory module
> 11, **but whether any amount of data for the I frame is
> being provided to the decoder buffer**. (Emphasis sup-
> plied.

Conversely, the text of dependent claim 4 expressly requires that:

> **parameters employed in encoding the data for the still image** produce an amount of data for the I frame that approaches, but remains less than, storage capacity of a buffer memory included in a decoder that stores the compressed video bitstream. (Emphasis supplied.)

Clearly, by its express text dependent claim 4:

1. applies to parameters employed in encoding compressed video data; and

2. requires that the parameters produce a specified amount of data for the I frame encoded from the data of the still image of independent claim 1 from which claim 4 depends.

Similar to the portion of the Examiner Answer's cited above from page 8 arguing that the claims of the present invention apply to motion video which, by jumping from the preamble of independent claim 1 to dependent claims 2 and 3, avoided express references to still images in the body of independent claim 1, in the text excerpted above from pages 14 and 15 the Examiner's Answer jumps past "parameters employed in encoding the data" that produce a particular result as required by the express text of dependent claim 4 to baldly assert that "**any amount of data for the I frame is being provided to the decoder buffer**" renders dependent claim 4 obvious under 35 U.S.C. § 103(a).

Clearly, in justifying the rejection of dependent claim 4 the Examiner's Answer wrongfully avoids that claim's express text. If a rejection of a claim can be justified by avoiding its text, then there exists no barrier to a capricious and arbitrary rejection of any claim of any patent application. That a buffer, such as that disclosed in the Florencio patent, holds some unspecified amount of data does not disclose, nor does it even suggest, a particular characteristic for "parameters employed in encoding the data." Absent such a disclosure or suggestion in the prior art references combined in rejecting dependent claim 4, that claim traverses rejection for obviousness under 35 U.S.C. § 103(a).

Conclusion

For the various reasons set forth above, claims 1-7 presently pending in this application can be rejected under 35 U.S.C. § 103(a) for obviousness only if one:

1. repeatedly contradicts oneself;

2. wrongfully avoids the claims as a whole;

3. wrongfully avoids the prior art references as a whole, particularly those portions thereof which argue against or teach away from the claimed invention;

4. wrongfully ignores controlling legal precedents;

5. wrongfully combines references that do not suggest their combination; and
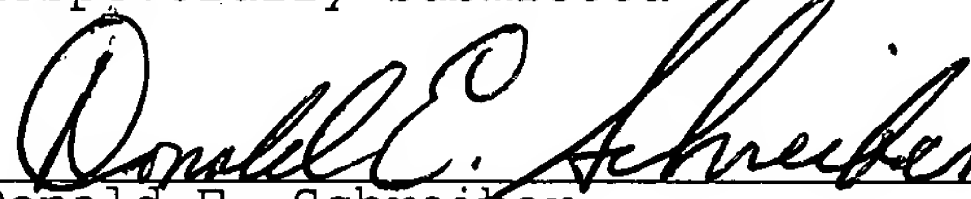
-22-

6.   wrongfully forms a nonobvious combination that renders the reference unusable for its intended purpose.

Clearly, the arguments presented above combined with the numerous internal contradictions between various arguments and rationales in the Examiner's Answer identified above prove that:

1.   the rejections of pending claims 1-7 lack merit; and

2.   the pending claims have been improperly and unlawfully rejected.

Thus, this Board must immediately bring an end to this canard by declaring the pending claims allowable.

Respectfully submitted

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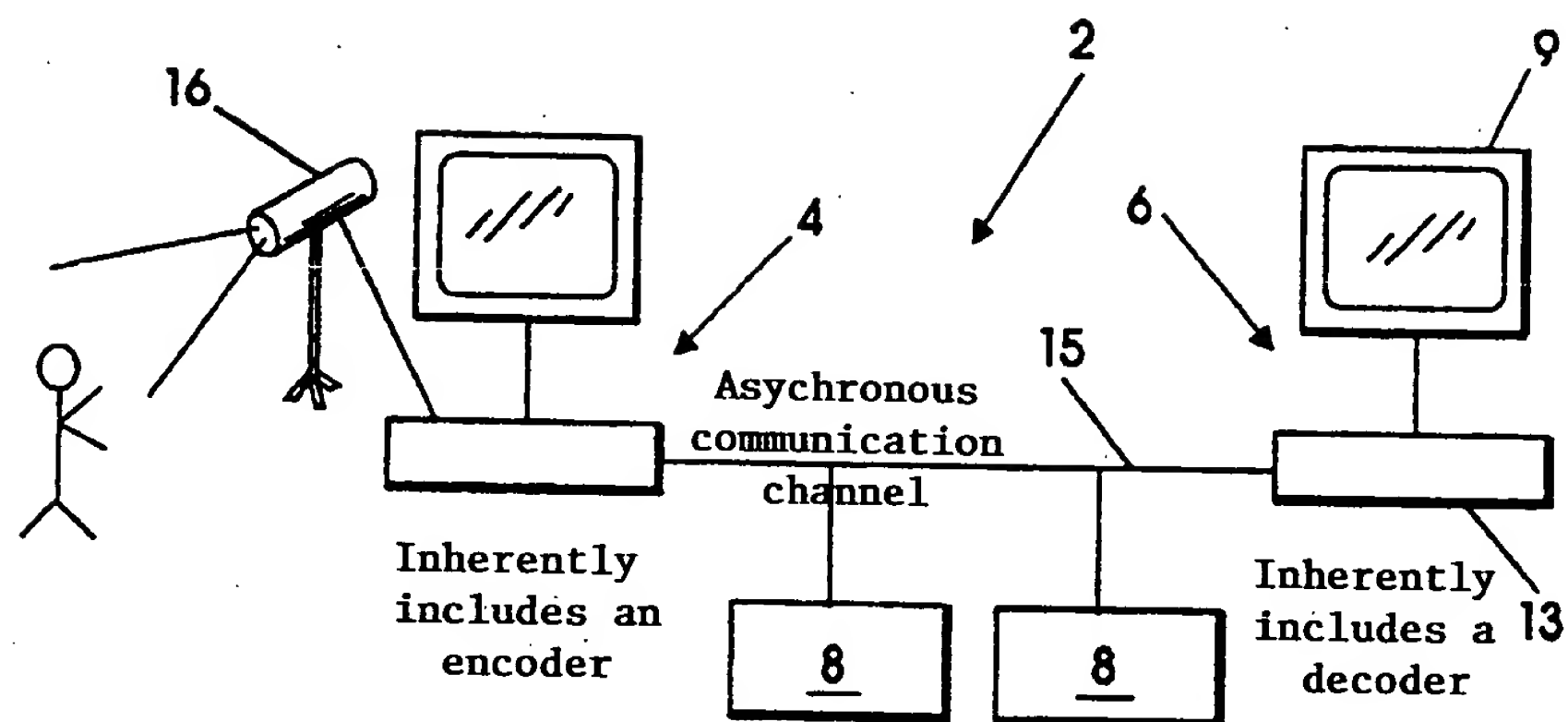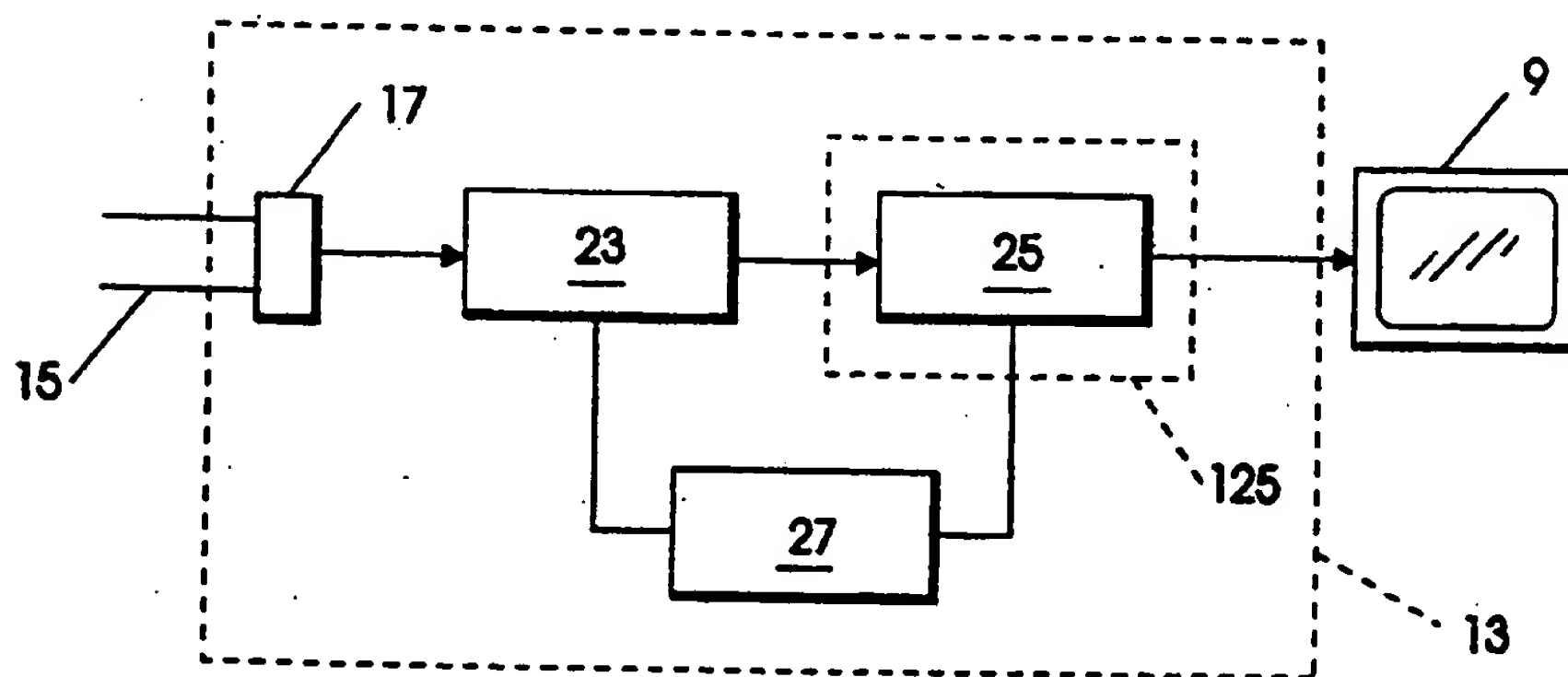-23-

FIG. 1

Asychronous communication channel

Inherently includes an encoder

Inherently includes a decoder

8   8

FIG. 2

17

23

25

27

9

15

125

13